

REMARKS

This paper is in response to the Office action mailed January 12, 2009 ("the Office Action"). The foregoing amendment cancels claim 11; amends claims 1, 5, 6, 10, 12, 14, 15, and 21-28; and adds new claim 28.¹ Claims 1-10 and 12-28 are now pending in view of the amendments. Applicants respectfully request reconsideration of the application in view of the above amendments to the claims and the following remarks. For Examiner's convenience and reference, Applicants present remarks in the order that the Office Action raises the corresponding issues.

In connection with the prosecution of this case and any related cases, Applicants have, and/or may, discuss various aspects of the disclosure of the cited references as those references are then understood by the Applicants. Because such discussion could reflect an incomplete or incorrect understanding of one or more of the references, the position of the Applicants with respect to a reference is not necessarily fixed or irrevocable. Applicants thus hereby reserve the right, both during and after prosecution of this case, to modify the views expressed with regard to any reference.

Please note that Applicants do not intend the following remarks to be an exhaustive enumeration of the distinctions between any cited references and the claims. Rather, Applicants present the distinctions below solely by way of example to illustrate some of the differences between the claims and the cited references. Finally, Applicants request that Examiner carefully review any references discussed below to ensure that Applicants' understanding and discussion of any reference is consistent with Examiner's understanding.

Unless otherwise explicitly stated, the term "Applicants" is used herein generically and may refer to a single inventor, a set of inventors, an appropriate assignee, or any other entity or person with authority to prosecute this application.

¹ The listing of claims in this paper incorporates the claim amendments in the preliminary amendment filed on September 10, 2004, which were inadvertently omitted in the previous two amendments dated February 15, 2008, and October 31, 2008.

Rejection under 35 U.S.C §103(a)

The Office Action rejects the claims under 35 U.S.C §103(a) as follows:

Claims 1-6 are rejected as being unpatentable over *Anderson et al.* (U.S. Patent No. 6,892,251) in view of *Parry* (U.S. Patent Publication No. 2002/0093424).

Claim 7 is rejected as being unpatentable over *Anderson* in view of *Parry*, as applied to claims 1-6 above, and in further view of *Roohparvar* (U.S. Patent No. 6,785,765).

Claims 8, 9, 11, 15, 17, 18, 22, 23, and 25-27 are rejected as being unpatentable over *Anderson et al.* in view of *Parry*, as applied to claims 1-6 above, and in further view of *Yukie et al.* (U.S. Patent No. 6,956,833).

Claims 10 and 16 are rejected as being unpatentable over *Anderson* in view of *Parry* and *Yukie*, as applied to claims 8, 9, 11, 15, 17, 18, 22, 23, and 25-27 above, and in further view of *Nakaoka et al.* (U.S. Patent Publication No. 2007/0027990).

Claims 12-14 are rejected as being unpatentable over *Anderson et al.* in view of *Parry*, *Yukie*, and *Nakaoka*, as applied to claims 10 and 16 above, and further in view of *Benjamin et al.* (U.S. Patent No. 5,668,654).

Claims 19 and 20 are rejected as being unpatentable over *Anderson* in view of *Parry* and *Yukie*, as applied to claims 8, 9, 11, 15, 17, 18, 22, 23, and 25-27 above, and further in view of *Kefford et al.* (U.S. Patent Publication No. 2003/0204726).

Claim 21 is rejected as being unpatentable over *Anderson et al.* in view of *Parry* and *Yukie*, as applied to claims 8, 9, 11, 15, 17, 18, 22, 23, and 25-27 above, and further in view of *Want et al.* (U.S. Patent No. 5,564,070).

Claim 24 is rejected as being unpatentable over *Anderson* in view of *Parry* and *Yukie*, as applied to claims 8, 9, 11, 15, 17, 18, 22, 23, and 25-27 above, and further in view of *Roohparvar* (U.S. Patent No. 6,785,765).²

Applicants respectfully traverse the rejection. To support an obviousness rejection, MPEP §2143.03 requires “all words of a claim to be considered.” Further, the Board of Patent Appeal and Interferences recently confirmed that a proper, post-KSR obviousness determination requires “a searching comparison of the claimed invention—including all its limitations—with the teaching of the prior art.” *In re Wada and Murphy*, Appeal 2007-3733 (BPAI 2008), citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Moreover, as the Supreme Court recently stated, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Claim 1, as amended, recites a communication module comprising, among other things, “a network interface, wherein the communication module performs [a] primary function over [a] network via the network interface, , the primary function including receipt of incoming network traffic via the network interface and performance of switching and/or routing operations on the received network traffic.” The Examiner alleged, “[A] host computer sending a print job to the printer by way of [a] printer card 139 and [a] host interface 153 is considered the primary function of the [*Anderson*] printer.” See *Office Action* at 3. See also *id.* at 8 (“*Anderson*’s printer communicating with a host computer using printer card and host interface to implement general functions of a printer is considered to be equivalent to applicant’s communication module performing a primary function.”) However, receiving print jobs from a host computer to implement general printer functions (e.g., printing the print jobs) does not teach or suggest “receipt of incoming network traffic via the network interface and performance of switching and/or routing operations on the received network traffic,” as claimed.

² Because *Anderson*, *Parry*, *Roohparvar*, *Yukie*, and *Nakaoka* are only citable under 35 U.S.C. §102(e), Applicants do not admit that *Anderson*, *Parry*, *Roohparvar*, *Yukie*, and *Nakaoka* are in fact prior art with respect to any or all of the claims of the present application, but rather reserve the right to swear behind *Anderson*, *Parry*, *Roohparvar*, *Yukie*, and/or *Nakaoka* in this application or a divisional, continuation, or CIP thereof.

For at least the foregoing reasons, Applicant respectfully submits that claim 1 is patentable over the cited art. Claim 15, as amended, recites at least some features generally similar to claim 1 and is patentable for at least the same reasons discussed herein. Because claims 1 and 15 are patentable as discussed herein, the dependent claims are patentable for at least the same reasons.

Moreover, the rejection of claims 19 and 20 is improper because *Kefford* does not qualify as prior art under any sub-section of 35 U.S.C. § 102. In particular, *Kofford* has a filing date of April 25, 2002, with no claim of priority, whereas Applicants are entitled to an earlier priority date of March 18, 2002, based on Applicants' foreign application and pursuant to 35 U.S.C. §365. Therefore, Applicants submit that the rejection of claims 19 and 20 should be withdrawn for this additional reason.

New Claim

As shown above, Applicants have added new claim 28. Support for such claim is found at least at page 11, lines 4-7 and page 14, lines 24-31. Applicants respectfully submit that claim 28 is allowable at least because the art of record does not teach or suggest "wherein the local wireless access enables the content of the first digital storage unit to be modified to change software and/or firmware used to accomplish the primary function of the communication module," as claimed.

Charge Authorization

The Commissioner is hereby authorized to charge payment of any of the following fees that may be applicable to this communication, or credit any overpayment, to Deposit Account No. 23-3178: (1) any filing fees required under 37 CFR § 1.16; (2) any patent application and reexamination processing fees under 37 CFR § 1.17; and/or (3) any post issuance fees under 37 CFR § 1.20. In addition, if any additional extension of time is required, which has not otherwise been requested, please consider this a petition therefor and charge any additional fees that may be required to Deposit Account No. 23-3178.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are allowable. In the event that Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview or overcome by an Examiner's Amendment, Examiner is requested to contact the undersigned attorney.

Dated this 13th day of July, 2009.

Respectfully submitted,

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